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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 1617

TECH CENTER 1600/2900

In re

Patent Application of

Richard B. Mazess

Application No. 09/995,911

Confirmation No.: 4126

Filed: November 28, 2001

Examiner: Criares, Theodore

"TREATMENT OF HYPERPROLIFERATIVE DISEASES USING ACTIVE VITAMIN D ANALOGUES"

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Transmitted herewith is a Response to Restriction Requirement in the above-identified application. Applicant claims small entity status.

It is believed that no additional fee is required. In the event Applicant has overlooked the need to request an extension of time, please consider this a request for same.

Charge or credit Deposit Account No. 50-0842 with any shortage or overpayment of the fees associated with this communication. A duplicate copy of this sheet is enclosed.

I, Diane J. Frauchiger, hereby certify that this correspondence is being deposited with the US Postal Service as first class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on the date of my signature.

Signature

Date of Signature

Respectfully submitted,

Jeffrey D. Peterson
Reg. No. 49,038

File No. 017620-9335

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Diane J. Frauchiger

Signature
April 21, 2003

Date of Signature

“TREATMENT OF HYPERPROLIFERATIVE
DISEASES USING ACTIVE VITAMIN D
ANALOGUES”

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This document is in response to the Office Action mailed on March 21, 2003, in which a one month period of response was set, this response being timely filed.

The Examiner has required restriction to one of two groups of claims, with the claims in Group I (claims 1, 3-8, 10-34 and 42-55) being drawn to methods of inhibiting hyperproliferation of malignant or neoplastic cells; and Group II (claims 35-41) being drawn to kits. The Office Action states that restriction to one of these two claim groups is necessary as the aforementioned claim groups are distinct from each other.

In response to the above-noted restriction requirement, applicants hereby elect the claims of Group I. (claims 1, 3-8, 10-34 and 42-55) with traverse.

The applicants hereby traverse the restriction requirement in its entirety. Restriction is only proper where "two or more independent and distinct inventions are claimed in one application" (35 U.S.C. § 121). Applicants respectfully submit that the two groups of claims identified by the Examiner are not directed to "independent and distinct inventions", but to different embodiments of the same invention.

In one embodiment, the invention provides methods of inhibiting hyperproliferation in malignant or neoplastic cells, while in another embodiment, the invention provides kits containing the components utilized in the claimed methods. The kit claims themselves (claims 35-41) all directly or indirectly depend from method claim 22. It should be clear from the disclosure of the invention that the claimed method set forth in claim 22 is a required limitation of each and every embodiment of claims 35-41, as instructions on performing the method is claimed directly or indirectly in each claim. Applicants submit that the claims of Group I and II are therefore not directed to separate and distinct inventions but to the same invention. Thus, restriction of any of the groups of the claims is improper under 35 U.S.C. § 121.

Applicants submit furthermore that even if the claim groups were directed to independent or distinct inventions, rather than two embodiments of the same invention, restriction would not be appropriate in this case for the following reasons. The Manual of Patent Examining Procedure ("MPEP") states that

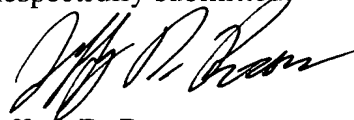
"If the search and the examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803

Applicants respectfully submit that all claims of the present invention could be examined together without placing any serious burden on the United States Patent and Trademark Office. The claims of Groups I and II are so inextricably related to one another

that, for the sake of efficiency, they should be examined in the same application. As is noted above, all of the kit claims (35-41) depend directly or indirectly on claim 22. Therefore, in order to perform a complete search on claims 35-41, a search would necessarily need to be performed on method claim 22. Given the close relationship between the claims of Groups I and II, prosecution of the claims in the same application would be administratively efficient by the Patent Office. Specifically, by prosecuting the applications together, the searches could be consolidated, and one Examiner could readily examine the subject matter of all the claims of the application at once.

Applicants therefore traverse the restriction requirements for the reasons set forth above.

Respectfully submitted,



Jeffrey D. Peterson
Reg. No. 49,038

Docket No.: 017620-9335
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